

VERSION WITH MARKINGS TO SHOW CHANGES MADE

1. (Amended) A business method relating to beverage containers comprising:

conveying by revenue producing sale a right to attach indicia to consumer removed, flexible and collectible protective members to be adhered to beverage containers;

manufacturing the protective members;

applying indicia to the protective members; and

adhering the protective members to the containers.

Add the following new claims:

--16. A business method relating to beverage containers comprising:

conveying by revenue producing sale a right to attach indicia to consumer removed, flexible and collectible protective members to be adhered to beverage containers;

manufacturing the protective members in an hourglass configuration to facilitate adherence to a top and convex side of a container without deformation and without wrinkling of a material of the protective member;

applying indicia to the protective members; and

adhering the protective members to the containers.

--17. A business method relating to beverage containers

comprising:

conveying by revenue producing sale a right to attach indicia to consumer removed, flexible and collectable protective members to be adhered to beverage containers;

manufacturing the protective members;

applying indicia to opaque protective members by printing on the underside thereof to facilitate using the method for such things as games of chance, premiums, collectibles, redeemables, merchandise acquisition means, and prizes without a user knowing in advance of protective member removal which of a plurality of chances the user has obtained; and

adhering the protective members to the containers.--

REMARKS

This is a Preliminary Amendment accompanying a continued application request pursuant to 37 C.F.R. § 1.114 following a final rejection. Also included is a petition for enlargement of time of one month to respond to the Office Action dated July 8, 2002, in which claims 1-15 remained pending and no claims were allowed. Applicant resubmits the above identified application following the foregoing claims amendment and the addition of two new claims. Reexamination, reconsideration and allowance of all 17 pending claims are respectfully requested. A clean copy of all currently pending claims as presently amended is attached hereto.

The Examiner withdrew the prior rejections as a result of the amendment of all claims to include revenue producing sales. The Examiner then based final rejections on a new reference, Blotky et al., U.S. Patent No. 6,084,526. But Blotky is an electronic device that bears no actual resemblance to the specification and drawings of the present invention. It is clear from the specification and drawings of the present application that the protective members are consumer removable, flexible, and can be collected and redeemed in a variety of ways that are set forth in the specification. See for, example page 1, lines 10 and 11, "consumer removable, flexible," page 12, line 25 "collected and redeemed," which provide the predicate for the additions to claim 1 as amended herewith.

New claim 16 combines newly amended claim 1 with claim 3. The Examiner earlier rejected claim 3, then a dependent claim, based on the earlier cited reference of Granofsky, U.S. Patent No.

5,108,003. In the first Office Action dated February 27, 2002, Examiner stated in paragraph 12, page 8, starting on line 9 as follows:

Regarding claim 3, Granofsky teaches the protective members adhering to the top and convex sides of the can without deformation and wrinkling of the member (Figures 4-5; column 2, lines 61-65, but is silent as to the members having an hourglass configuration. Selection of a particular shape of the protective members would have been within [the] purview of one of ordinary skill in the art at the time the invention was made depending on the shape of the can.

That characterization of Granofsky is respectfully traversed and is the subject of Applicant's strong objection. Figures 4 and 5 teach nothing about protective members adhering to the top and convex sides of the can without deformation and wrinkling. In fact, they show substantial wrinkling upon removal from the can. Only a very small portion of the protective member is seen still adhered to the can, it teaches nothing about the absence of deformation, and is way too small to fairly show anything about the absence of wrinkling when adhering to the top and convex side of a can. Moreover, there is no description to support the Examiner's interpretation of what these figures allegedly show. The Examiner cites column 2, lines 61-65 of Granofsky in support of the rejection. That language is as follows:

Then the tab 26 is pulled upwardly causing the wall of the cover 10 to be removed from approximately half of the upper end of the can, as seen in FIG. 4. The material of the cover is not severed when this occurs but simply is rolled backwards.

On the other hand, the present specification makes very

explicit assertions as to why the hourglass shape is important, and no known art shows the use of such a shape for such a specific purpose. It is not the idle selection of a shape, it is the discovery that the shape has very specific benefits that are new and unobvious in avoiding deformation and wrinkling. The present specification recites at page 10 beginning at line 4 as follows:

The hourglass shape has been found to permit adherence to the top and convex side of a container without deformation of the protective member's material, and without wrinkling. This is important to avoid air pockets or bubbles, which could become sites for bacterial contamination.

With all due respect to the Examiner, proper rejection of this important inventive concept requires more than incorrect citation of a reference that does not teach what Applicant has claimed in claims 3 and 16, and it is not an insignificant

[s]election of a particular shape of the protective members [which] would have been with [the] purview of one of ordinary skill in the art at the time the invention was made  
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as the Examiner asserts. What is the authority for the contention that this purposeful shaping of the protective member is within the purview of one of ordinary skill in the art at the time the invention was made? Applicant respectfully requests that the rejection be withdrawn.

Turning finally to new claim 17, what is present is a combination of new claim 1 and former claims 6, 9, 10, and 11. There does not appear to be any prior art of record that shows the combination of a consumer removed, flexible and collectible

protective member that can be redeemed for games of chance, premiums, collectibles, redeemables, merchandise acquisition means, and prizes without a user knowing in advance of protective member removal which of a plurality of chances the user has obtained.

Although Applicant believes that all the presently pending claims are now in condition for allowance, undersigned counsel remains available to a telephone interview if doing so will facilitate the resolution of any remaining technicalities, such as may be the proper subject of an Examiner's Amendment with the concurrence of undersigned counsel. In the event such an interview would be of use, the Examiner is respectfully invited to telephone undersigned counsel at the telephone number listed below.

Respectfully submitted,

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CERTIFICATE OF MAILING

I HEREBY CERTIFY that the foregoing paper has being deposited with the United States Postal Service as Express Mail No. EV 065066730 US in an envelope addressed to: Honorable Commissioner of Patents & Trademarks, Box: CPA, Washington, D.C. 20231, this 7th day of November, 2002 which is neither a Saturday, Sunday, or federal holiday within the District of Columbia, and I accordingly claim the filing date of **November 7, 2002** of this paper as provided for in 37 CFR 1.10.

Respectfully submitted,

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